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L. Garren Du

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* L. GARREN DU, BRYANT CHIH-MING LEE,  
GABRIEL MARTIN FLORES, and  
WILLIAM HENRY MICELI

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Appeal 2009-007445  
Application 09/879,267  
Technology Center 3600

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Decided: November 20, 2009

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Before HUBERT C. LORIN, ANTON W. FETTING, and  
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF THE CASE

L. Garren Du, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-40, 43, 44, and 50-55. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

## SUMMARY OF DECISION

We AFFIRM.<sup>1</sup>

## THE INVENTION

The invention relates to digital content publication.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A computer-implemented method comprising:
  - receiving digital content and metadata associated with the digital content;
  - receiving publication information comprising distribution information that identifies one or more content distributors selected to distribute the digital content;
  - storing the digital content at a first computing system; and
  - sending the metadata and the publication information to a second computing system for storage separately from the first computing system.

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<sup>1</sup> Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed May 24, 2007) and Reply Brief ("Reply Br.," filed Dec. 19, 2008), and the (Second) Examiner's Answer ("Answer," mailed Dec. 9, 2008).

## THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Downs	US 6,226,618 B1	May 1, 2001
Sasaki	US 2002/0077988 A1	Jun. 20, 2002
Padhye	US 2003/0023564 A1	Jan. 30, 2003
Niwa	US 2003/0225696 A1	Dec. 4, 2003
Saito	EP 1 041 823 A2	Oct. 4, 2000

The following rejections are before us for review:

1. Claims 54 and 55 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.
2. Claims 1-6, 9, 10, 14-19, 22, 23, 26-32, 35, 36, 40, 43, 44, and 50-55 are rejected under 35 U.S.C. §103(a) as being unpatentable over Sasaki and Niwa.<sup>2</sup>
3. Claims 7, 13, 20, 33, and 39 are rejected under 35 U.S.C. §103(a) as being unpatentable over Sasaki, Niwa, and Downs.
4. Claims 8, 21, and 34 are rejected under 35 U.S.C. §103(a) as being unpatentable over Sasaki, Niwa, and Saito.

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<sup>2</sup> The statement of the rejection failed to include claims 26 and 35 (see Answer 3) but the Appellants do not appear to make that an issue. Rather, the Appellants style the rejection as being directed to the independent claims 1, 14, 27, and 40 and then treat all the claims together. See App. Br. 6. Accordingly, we will view as inadvertent that claims 26 and 35 as missing from the statement of the rejection and include them with the claims on which they depend (i.e., claims 14 and 53, respectively).

5. Claims 11, 12, 24, 25, 37, and 38 are rejected under 35 U.S.C. §103(a) as being unpatentable over Sasaki, Niwa, and Padhye.

### ARGUMENTS

The Appellants argue that combination of Sasaki and Niwa would not lead one of ordinary skill in the art to the claimed subject matter because (1) the “[p]roposed modification would render Sasaki unsatisfactory for its intended purpose” (App. Br. 8); (2) the “[p]roposed modification changes Sasaki’s principle of operation” (App. Br. 9); and (3) there is “[n]o motivation to combine the references” (App. Br. 10).

### ISSUES

The issue is whether the Appellants have shown error in the Examiner’s reasoning that the cited prior art combination would have led one of ordinary skill in the art to the claimed subject matter whereby “metadata” for digital content in association with publication information is stored separately from the digital content.

### FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

#### *Claim construction*

1. Claim 1 calls for “digital content.”
2. According to the Specification, “digital content” “can include at least

- one of streaming video content, music content, graphic content, printed content, or audio content.” Specification 3:7-9.
3. Claim 1 calls for a “metadata.”
  4. The Specification does not provide a definition for “metadata” but discloses that it “may include at least one of a name, length, publisher, location, or description associated with the digital content.” Specification 3:9-11.
  5. The definition of “metadata” is “[a] classification scheme for indexing a certain type of data and making it more readily available.” See Webster’s New World Dictionary of Computer Terms 342 (8th Ed. 2000.)(Entry for “metadata.”)
  6. Claim 1 calls for “publication information comprising distribution information that identifies one or more content distributors selected to distribute the digital content.”
  7. According to the Specification, “public information” “may include at least one of pricing, rights, or catalog information associated with the digital content.” Specification 3:11-13.

*The scope and content of the prior art*

8. Sasaki relates to distributing digital content.
9. Sasaki discloses a digital content transfer file comprising metadata, with public and private keys, is used to enable a license manager to track and control the distribution of digital content. Sasaki [0038] and Fig. 4.
10. Sasaki discloses transferring a file containing an encrypted content package having a header “B” (element 139) and digital content (element 141); the header “B” including a “Distributor ID B” (element

135). See Fig. 4 .

11. According to the Examiner,

Sasaki discloses digital content and metadata associated with the digital content (i.e. the metadata is implemented as a content header that includes information relating to an associated digital work), receiving publication information comprising distribution information that identifies one or more content distributors (i.e. ... .”

Answer 3

12. Accordingly, the Examiner appears to equate Sasaki’s header “B” to the “metadata” of the claimed method.

13. The Examiner appears to equate Sasaki’s “Distributor ID B” to the “publication information comprising distribution information that identifies one or more content distributors selected to distribute the digital content” (claim 1) of the claimed method.

14. That (FF 13) is also the Appellants’ interpretation of the Examiner’s position. App. Br. 7.

15. The Appellants do not dispute that Sasaki’s header “B” can be equated to the instant “metadata” or that Sasaki’s “Distributor ID B” can be equated to the “publication information comprising distribution information that identifies one or more content distributors selected to distribute the digital content” (claim 1).

16. The Examiner concedes that “Sasaki does not expressly disclose sending the metadata [i.e., Sasaki’s header “B”] and publication information to a second computing system for storage separately from the first computing system.” Answer 4.

17. According to the Examiner, “Niwa discloses sending the metadata and the publication information (i.e. information describing the

- content) to a second computing system for storage separately from the first computing system ... .” Answer 4, citing Niwa paras. [0072] and [0073].
18. Niwa relates to presenting customized multimedia content.
19. Referring to Figs. 1 and 6, paras. [0072] and [0073] of Niwa disclose a content database 36 including a description database 130 and a video segment database 132 for storing information describing the content of the video segments and the video segments, respectively.
20. The Examiner appears to equate Niwa’s descriptive information to the “metadata” of the claimed method and Niwa’s video segments to the content of the claimed method.
21. That (FF 20) is also the Appellants’ interpretation of the Examiner’s position. App. Br. 8.
22. The Appellants do not dispute that Niwa’s descriptive information could be equated to the “metadata” of the claimed method and Niwa’s video segments to the content of the claimed method.
- Any differences between the claimed subject matter and the prior art*
23. The claimed method differs from the prior art in reciting the term “metadata” and expressly requiring “metadata” to be stored separately from other information.
- The level of skill in the art*
24. Neither the Examiner nor the Appellants have addressed the level of ordinary skill in the pertinent art of information distribution. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level



of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (*quoting Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

*Secondary considerations*

25. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

## PRINCIPLES OF LAW

*Claim Construction*

During examination of a patent application, a pending claim is given the broadest reasonable construction consistent with the specification and should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004). “[W]e look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation. As this court has discussed, this methodology produces claims with only justifiable breadth. *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984). Further, as applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee. *Am. Acad.*, 367 F.3d at 1364.” *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007). Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003).

*Obviousness*

Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’

*KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” *Graham*, 383 U.S. at 17-18.

ANALYSIS

*The rejection of claims 54 and 55 under 35 U.S.C. §101 as being directed to non-statutory subject matter.*

The Notice of Appeal indicates that the rejection of all the claims 1-40, 43, 44, and 50-55 is appealed (Notice of Appeal, filed Jan. 23, 2007) and claims 54 and 55 have not since been cancelled. Rather, the Reply Brief now indicates that Appellants have withdrawn the appeal as to claims 54 and 55 without further comment. Reply Br. 1. Thus, the Appellants have

waived arguments rebutting the rejection of claims 54 and 55. The rejection of claims 54 and 55 remains pending but uncontested. Accordingly, the rejection of claims 54 and 55 is summarily affirmed.

*The rejection of claims 1-5, 10, 14-18, 23, 26-31, 35, 36, 40, 43, and 50-55 under 35 U.S.C. §103(a) as being unpatentable over Sasaki and Niwa.*

The Appellants argued claims 1-5, 10, 14-18, 23, 26-31, 35, 36, 40, 43, and 50-55 as a group (App. Br. 6). We select claim 1 as the representative claim for this group, and the remaining claims 2-5, 10, 14-18, 23, 26-31, 35, 36, 40, 43, and 50-55 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Appellants argue that combination of Sasaki and Niwa would not lead one of ordinary skill in the art to the claimed method because the “[p]roposed modification would render Sasaki unsatisfactory for its intended purpose” (App. Br. 8). Specifically, the Appellants argue that Sasaki’s computing system requires the metadata and content to be on a single system in order to carry out its intended purpose - which is to prevent misappropriation of copyrighted content. App. Br. 8. According to the Appellants, Sasaki would fail to carry out that purpose if Sasaki were to be modified so that the metadata and content are stored on different systems.

The difficulty with this argument is that the claimed method does not require a computing system to carry out anything more than storing different types of information. Sasaki’s computing system is employed for distributing digital content. A digital content transfer file comprising metadata, with public and private keys, is used to enable a license manager to track and control the distribution of digital content. FF 9. In the context

of such a distribution system, the dislocation of the metadata from the digital content could possibly impact its operation. However, the claimed method is not narrowly directed to such a system, but is broadly directed to storing metadata and digital content on different systems. In the context of storing different types of information on different systems, Sasaki's disclosure of the types of information recited in the claim combined with Niwa's disclosure of different systems storing different types of information would have led one of ordinary skill in the art to store the different types of information recited in the claim on different systems. As expected, the result would be different types of information on different systems.

"[W]hen a patent 'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one would expect from such an arrangement, the combination is obvious." *KSR* at 417. In that regard, there is no evidence of secondary consideration. FF 25.

The Appellants also argue that combination of Sasaki and Niwa would not lead one of ordinary skill in the art to the claimed method because the "[p]roposed modification changes Sasaki's principle of operation" (App. Br. 9). Here, again, the Appellants point out that "Sasaki relies heavily on the presence of both the header 139 and content 141 in the same computing system." App. Br. 9. However, the necessity of that reliance lies in the purpose for Sasaki's invention; that is, in a system for controlling the distribution of digital content. The scope of the claimed method is not narrowly confined to controlling the distribution of digital content. Accordingly, distinguishing the claimed method from that of Sasaki on the ground that Sasaki's distribution control of digital content requires the

header (i.e., metadata) and digital content to be on the same system is not an argument that is commensurate in scope with what is claimed.

The Appellants argue that combination of Sasaki and Niwa would not lead one of ordinary skill in the art to the claimed method because there is “[n]o motivation to combine the references” (App. Br. 10). The argument specifically raises questions of hindsight (App. Br. 10), of the motivation not being present in the prior art disclosures (App. Br. 11); of the Examiner not providing a convincing line of reasoning (App. Br. 11; 13-15); and, of the cited references not providing any suggestion to make the combination to arrive at the claimed subject matter (App. Br. 12). We are not persuaded by this argument.

As to the question of hindsight, while “[w]e must still be careful not to allow hindsight reconstruction of references to reach the claimed invention without any explanation as to how or why the references would be combined to produce the claimed invention,” *Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1374 n.3 (Fed. Cir. 2008), the Examiner’s reasoning, given the breadth of the claim, is sound. *Cf. KSR* at 421 (“The Court of Appeals, finally, drew the wrong conclusion from the risk of courts and patent examiners falling prey to hindsight bias.”) “Rigid preventative rules that deny factfinders recourse to common sense, however, are neither necessary under our case law nor consistent with it.” *KSR* at 421. All that is required by the claimed method is storing different types of information on different computing systems. The Appellants do not explain why one of ordinary skill in the art would not have been led to the claimed method, given the reasonably broad construction of the claim as covering storing different types of information on different computing systems, given Sasaki’s

disclosure of the information and Niwa's disclosure of the storing different types of information on different systems.

As to the questions of the motivation not being present in the prior art disclosures and of the cited references not providing any suggestion to make the combination to arrive at the claimed subject matter, "[t]he obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents." *KSR* at 419.

Finally, as to the question of the Examiner not providing a convincing line of reasoning, we disagree. Given the breadth of the claim, the Examiner's apparent reasoning for the legal conclusion of obviousness is sound. The Appellants' criticism is not persuasive as to error in the Examiner's reasoning because it is not commensurate in scope with what is claimed. For example, the Appellants argue that Niwa does not store content and metadata on different systems because Niwa is not directed to restricting access to digital content. App. Br. 13-14. However, the claimed method is not directed to restricting access to anything.

*The rejection of claims 6, 9, 19, 22, 32, 35, and 44 under 35 U.S.C. §103(a) as being unpatentable over Sasaki and Niwa.*

The Appellants did not specifically address this rejection. Accordingly, we find the Appellants have not shown error in the rejection of claims 6, 9, 19, 22, 32, 35, and 44.

*The rejection of claims 7, 13, 20, 33, and 39 under 35 U.S.C. §103(a) as being unpatentable over Sasaki, Niwa, and Downs.*

The Appellants did not specifically address this rejection. Accordingly, we find the Appellants have not shown error in the rejection of claims 7, 13, 20, 33, and 39.

*The rejection of claims 8, 21, and 34 under 35 U.S.C. §103(a) as being unpatentable over Sasaki, Niwa, and Saito.*

The Appellants did not specifically address this rejection. Accordingly, we find the Appellants have not shown error in the rejection of claims 8, 21, and 34.

*The rejection of claims 11, 12, 24, 25, 37, and 38 under 35 U.S.C. §103(a) as being unpatentable over Sasaki, Niwa, and Padhye.*

The Appellants did not specifically address this rejection. Accordingly, we find the Appellants have not shown error in the rejection of claims 11, 12, 24, 25, 37, and 38.

## CONCLUSIONS

We conclude that the Appellants have not shown that the Examiner erred in rejecting claims 54 and 55 under 35 U.S.C. §101 as being directed to non-statutory subject matter; claims 1-5, 10, 14-18, 23, 27-31, 36, 40, 43, and 50-55 under 35 U.S.C. §103(a) as being unpatentable over Sasaki and Niwa; claims 6, 9, 19, 22, 32, 35, and 44 under 35 U.S.C. §103(a) as being unpatentable over Sasaki and Niwa; claims 7, 13, 20, 33, and 39 under 35 U.S.C. §103(a) as being unpatentable over Sasaki, Niwa, and Downs; claims 8, 21, and 34 under 35 U.S.C. §103(a) as being unpatentable over Sasaki, Niwa, and Saito; and, claims 11, 12, 24, 25, 37, and 38 under 35 U.S.C.

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§103(a) as being unpatentable over Sasaki, Niwa, and Padhye.

### DECISION

The decision of the Examiner to reject claims 1-40, 43, 44, and 50-55 is affirmed.

### AFFIRMED

MP

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